

REMARKS

Claims 1-20 are pending, of which claims 1, 8, 11, 13, and 14 have been amended. No new matter has been introduced by the amendments to claims 1, 8, 11, 13, or 14. Reconsideration and allowance of all pending claims of this application in light of the foregoing amendments and the following remarks are respectfully requested.

Rejections Under 35 U.S.C. §102

Claims 1-5, 7, 8, and 10-19 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,240,445 to Kumar et al. (hereinafter “Kumar”). Applicants respectfully traverse the subject rejection for the following reasons.

In particular, the PTO provides in MPEP § 2131 that “[t]o anticipate a claim, the reference must teach every element of the claim. . . .” Therefore, with respect to each of independent claims 1 and 8, to sustain this rejection, the Kumar reference must contain all of the elements of the subject claim.

However, it is apparent that Kumar fails to disclose “translating the identifier into a group identification representative of a plurality of identifiers” as recited in claim 1. In rejecting claim 1 as being anticipated by Kumar, the Examiner equates the shared fax receipt number 30 and unique identifier (“ID”) 38 of Kumar with Applicants’ claimed “identifier” and then points to Figs. 2 and 3 of Kumar as teaching the claimed “translating” step. However, as set forth in the description of Fig. 3 of Kumar at column 7, lines 4-14 thereof, the PSTN 16 processes “the first 10 digits of the dialed number, representing the shared fax receipt number 30, and completes the telephone connection to the computer 18. At this point, facsimile machine 14 has not yet completed the dialing sequence As facsimile machine 14 completes the dialing sequence by transmitting the unique identifier 38, the computer 18 parses the unique identifier and identifies the intended recipient of the facsimile message.” It is clear from the foregoing that Kumar does not teach “translating the identifier into a group identifier”; rather, the first 10 digits of Kumar’s so called “identifier” are processed by the PSTN 16 to complete a connection between the transmitting facsimile machine 14 and the computer 18 (illustrated in Fig. 3). After a connection is made, only the remainder of the “identifier” (i.e., the unique dialing sequence 38) is “translated” by the computer 18. Accordingly, contrary to the Examiner’s position, the entire “identifier” is not received, and therefore cannot be translated, by the computer 18 shown in Fig. 3. Even assuming that the Examiner is correct in equating Applicants’ claimed “identifier” with the shared fax receipt number 30/unique identifier 38 combination taught by Kumar and in equating Applicants’ claimed “group identification” with Kumar’s

shared fax receipt number 30, Kumar clearly fails to teach translating the former into the latter, as required by independent claim 1.

Additionally, it is apparent that Kumar fails to disclose “responsive to translating the identifier, indexing an address table with the group identification” as recited in independent claim 1. In this regard, the Examiner points to column 7, lines 10-30 and 60-65, and column 9, lines 5-30, of Kumar as teaching “indexing an address table” and to Fig. 7, element 110, of Kumar as teaching “with the group identification”. As indicated above, the Examiner has equated Kumar’s shared fax receipt number 30 with the claimed “group identification”. However, as explained in detail above, only the unique identifier 38 (a.k.a., “user ID 40”) is provided to the computer 18 for processing; accordingly, the cited portions of Kumar teach only mapping of the unique identifier 38/user ID 40, not indexing using the group identification, as required by independent claim 1.

Accordingly, the subject rejection of independent claim 1 is not supported by Kumar and should be withdrawn. Independent claim 8 contains limitations similar to those of claim 1 described above and is therefore also allowable over Kumar for the same reasons as set forth with respect to claim 1. Claims 4-5, 7, and 10-19 depend from and further limit claims 1 and 8 and are therefore also allowable over Kumar for at least the same reasons set forth above with respect to claim 1.

Rejections under 35 U.S.C. §103

Claims 6, 9, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar as applied to claims 1 and 8, and further in view of U.S. Patent No. 6,161,144 to Michels et al. (hereinafter “Michels”). In response, Applicants respectfully traverse the rejection and submit that, because claims 6, 9, and 20 depend from and further limit claims 1 and 8, the claims are allowable for at least the same reasons set forth above with respect to claims 1 and 8.

Moreover, with regard to claims 6 and 9, there is another compelling reason why the Kumar and Michels references cannot be combined and applied to reject those claims under 35 U.S.C. §103(a).

The PTO provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. . . . [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In the present case, Kumar and Michels do not teach, or even suggest, the desirability of the combination since neither teaches or suggests translating the identifier into a group identification using a hashing function. Thus, neither of the patents provides any incentive or motivation supporting the desirability of the combination. Specifically, even assuming *arguendo* that, as asserted by the Examiner, the combination of the shared fax number 30 and unique identifier 38 disclosed by Kumar is equivalent to Applicants' claimed identifier, and that merely dropping the unique identifier from the shared fax number equates to "translation" of that combination into a group identifier, it would be counterintuitive to apply a hashing function, as taught by Michels, to so translate the "identifier" of Kumar into a group identification in view of the fact that the transformation of Kumar's "identifier" into a "group identifier" can be simply performed by simply dropping the unique identifier 38 appended to the end of the shared fax number 30. As a result, not only do the references provide no basis for the combination, Kumar actually teaches away from the combination.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 6 and 9.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.
(emphasis in original)

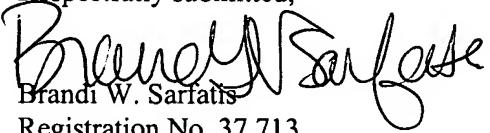
In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 6 and 9. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 6 and 9 and the rejection under 35 U.S.C. §103(a) is not applicable.

Conclusion

It is clear from the foregoing that independent claims 1 and 8 are in condition for allowance. Claims 2-7 and 9-20 depend from and further limit claims 1 and 8 and are therefore also deemed to be in condition for allowance.

In view of the foregoing, an early formal notice of allowance of claims 1-20 is requested. The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


Brandi W. Sarfatis

Registration No. 37,713

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HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 214/651-5896
Facsimile: 214/200-0948
Client Matter No.: 14882USRR01/22171.391

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Debbie Ludwig